

REMARKS

Claims 14, 16 and 23-27 are pending and stand ready for further action on the merits. Claims 26 and 27 have been withdrawn from consideration as being drawn to non-elected subject matter.

*Issues Under 35 U.S.C. § 112, First Paragraph*

The Examiner has maintained the rejection of claims 14, 16 and 23-25 under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse the rejection.

Specifically, the Examiner has maintained the position that the concentration ranges of 20-30 wt. % and 25-30 wt. % as described in the last clause of claim 14, constitute new matter despite Applicants assertion to the contrary. Applicants respectfully submit that there is sufficient *implicit* support for the range of 20-30 wt. % by combining the range of 0.001-30 wt. % with the range of 0.01-20 wt. %, both of which are disclosed on page 3, line 15 of the present specification.

Also, there is sufficient *implicit* support for the range of 25-30 wt. % by combining the range of 0.001-30 wt. % as disclosed on page 3, line 15 with the lower limit of 25 wt. % as would be found from the example given on page 6, lines 5-8 of the present specification.

Applicants respectfully submit that the current case law supports Applicants' position.

"The written description requirement does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed'" (citation omitted). *Union Oil of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997, 54 USPQ2d 1227, 1232 (Fed. Cir. 2000).

With respect to amending numerical range limitations, such as in our case, the Examiner's analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure.

In the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), at issue was whether the claim limitation of "between 35% to 60%" by weight of coffee solids constituted "new matter." The specification recited a range of 25% to 60% and exemplified processes using 36% and 50% solids.

The court concluded that

[i]]n the context of this invention, in light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35- 60% solids content range to be part of appellants' invention.... The PTO has done nothing more than argue lack of literal support, which is not enough.

Similarly, in *In re Blaser*, 194 USPQ 122, 126 (CCPA 1977) the claims recited "heating the reaction blend ... obtained after completing of said mixing to 80° C to 200° C." The specification disclosed initially mixing the starting materials (at temperatures of up to 80° C) and then heating the reaction blend to temperatures between 60° C and 200° C. The court framed the issue as "whether the disclosed range of 60° C to 200° C in [the specification] supports the recitation of 80° C to 200° C in the claims on appeal."

Appellants in *Blaser* relied on the rationale of *In re Wertheim*, *supra*, as "clearly applicable here." Appellants urged that if a disclosure of 25-60% solids content taught those skilled in the art that 35-60% was part of the invention in *Wertheim*, although the latter range was not expressly mentioned

therein, then appellants' disclosure of 60° C to 200° C in the specification would likewise teach 80° C to 200° C as part of appellants' invention. The *Blaser* court agreed with appellants and found that the range of 80° C to 200° C was not new matter.

Also at issue in *Blaser*, was whether the phrase "said share of said water in said mixture is from 1.2 to 1.6 mols" had support in a parent case U.S. Serial No. 159,159. If this range did not have support, it would be new matter to the present application and claim 12 would not have the benefit of priority back to the filing date of the parent case. The court noted that in the parent application, there was a range with an upper limit of 1.6 mols which was expressly disclosed and examples 1-6 therein encompassed the range of 1.2 to 1.5 mols. The court found that, "[a]s a factual matter, persons skilled in the art would consider processes employing 1.2 to 1.6 mols water as part of appellants' invention and would have been led by U.S. Serial No. 159,159 so to conclude."

In the present case, the Examiner has done nothing more than to argue lack of literal support, which is not enough. *In re Lukach*, 169 USPQ at 796, (CCPA 1971), holds that for a proper rejection based on new matter, the Examiner not only has the burden of showing that the claimed invention is not literally

described in the specification, but also the Examiner has the burden to give reasons why there is not implicit written description support.

Indeed, based on the above-cited case law, it is proper to find sufficient implicit support for the range of 20-30 wt. % by combining the range of 0.001-30 wt. % with the range of 0.01-20 wt. %, both of which are disclosed on page 3, line 15 of the present specification. Also, it is proper to find sufficient implicit support for the range of 25-30 wt % by combining the range of 0.001-30 wt. % as disclosed on page 3, line 15 with the lower limit of 25 wt. % from the example given on page 6, lines 5-8 of the present specification.

Accordingly, no new matter has been added to the disclosure by way of the July 7, 2003 Amendment to claim 14. Since Applicants were in possession of the invention described in presently amended claim 14 as of the instant priority date, withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

**Conclusion**

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. A Notice to such effect is earnestly solicited.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of three (3) months to January 29, 2004 in which to file a reply to the Office Action. The required fee of \$950.00 is enclosed herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

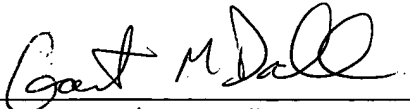
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

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required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Marc S. Weiner, #32,181

Garth M. Dahlen, Ph.D., #43,575

MSW/GMD/gh  
20-4518P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000